

REMARKS**I. Summary**

Claims 1-21 have been rejected in the non-final Office Action mailed February 18, 2005. Claims 1 and 13 have been amended to recite additional limitations fully supported by the specification. Accordingly, no new matter has been added. Claims 12 and 24 have been cancelled without prejudice. The specification was amended to update the status of related applications. The issues in the Office Action are:

- Claims 1 and 13 are rejected under 35 U.S.C. § 112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.
- Claims 1, 2, 8, 11, 13, 14, 20, and 23 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Molitor* (U.S. Patent No. 5,827,567).
- Claims 9, 10, 12, 21, 22, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Chen et al.* (U.S. Patent No. 5,709,949, hereinafter *Chen*).
- Claims 4, 6, 7, 16, 18, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Dutheil et al.* (U.S. Patent No. 5,891,515, hereinafter *Dutheil*).
- Claims 5 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Parthasarathy* (U.S. Patent No. 4,104,416).
- Claims 3 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Niskanen et al.* (U.S. Patent No. 5,342,812, hereinafter *Niskanen*).

II. Rejection of Claims under 35 U.S.C. § 112, 2nd paragraph

Claims 1 and 13 are rejected under 35 U.S.C. § 112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant

regards as the invention. The Examiner states in the rejection that “Claims 1, 13 are vague and indefinite because it is unclear if the coated tool forms the ‘composite structure on the tool’ or if a composite structure is formed as a product on the coated tool.” Applicant points out that definiteness of claim language must be analyzed in light of: “(A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” *See M.P.E.P. § 2173.02.* Applicant respectfully traverses these claim rejections.

Claims 1 and 13 recite the steps of “curing the primer and coating applied to the tool” and “forming the composite structure on the tool.” These are clearly two separate steps in the claimed methods. Accordingly, one of ordinary skill in the art would understand that “curing the primer and coating applied to the tool” is not duplicative of “forming the composite structure on the tool.” The claimed subject matter is also clearly described at, for example, page 3, lines 6-26. Applicant respectfully asserts that, considering the content of the application disclosure and the claim interpretation that would be given by one of ordinary skill in the art, claims 1 and 13 are definite according to an analysis under M.P.E.P. § 2173.02. Applicant respectfully requests that the rejection of claims 1 and 13 under 35 U.S.C. § 112, 2nd paragraph be withdrawn.

III. Rejection of Claims under 35 U.S.C. § 102(b)

Claims 1, 2, 8, 11, 13, 14, 20, and 23 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Molitor*. Applicant respectfully traverses the rejection of these claims. To anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim. *See M.P.E.P. § 2131.*

Claim 1 has been amended to recite the additional limitation of “applying a surfactant solution to a surface of a tool and drying said surfactant solution to form a surfactant-coated surface.” The recited language is taken in part from claim 12, which has been cancelled. *Molitor* teaches a method of preparing a game ball mold cavity. *See* col. 1, lines 6-7. *Molitor* teaches a mold cavity preparation technique comprising in the first step shot peening or air blasting using an abrasive media. *See* col. 1, lines 24-59. “After blasting, the hemispherical

opening and land area of the mold cavity are primed. *See id.* *Molitor* does not teach applying a surfactant solution before priming. Accordingly, *Molitor* does not teach at least “applying a surfactant solution to a surface of a tool” as recited in claim 1. Thus, *Molitor* does not anticipate claim 1.

Claim 13 also recites “applying a surfactant solution.” Therefore, for the reasons shown above, *Molitor* does not teach all limitations of claim 13. Thus, *Molitor* does not anticipate claim 13.

Dependent claims 2, 8, 11, 14, 20, and 23 depend directly or indirectly from either base claim 1 or 13. As such, each of the dependent claims comprise all limitations of the base claim from which it depends. As shown above, *Molitor* does not teach all limitations of claims 1 and 13. Accordingly, *Molitor* does not teach all limitations of dependent claims 2, 8, 11, 14, 20, and 23, and does not anticipate these claims. In view of the above, Applicant respectfully requests that the rejection of claims 1, 2, 8, 11, 13, 14, 20, and 23 under 35 U.S.C. § 102(b) be withdrawn and these claims passed to allowance.

IV. Rejection of Claims under 35 U.S.C. § 103(a)

Claims 9, 10, 12, 21, 22, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Chen*. Claims 4, 6, 7, 16, 18, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Dutheil*. Claims 5 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Parthasarathy*. Claims 3 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Niskanen*. Applicant respectfully traverses these claim rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. *See* M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria,

Applicant respectfully asserts that the references do not teach or suggest all the claim limitations.

A. Claims 9, 10, 12, 21, 22, and 24

Claims 9, 10, 12, 21, 22, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Chen*. Claims 12 and 24 have been cancelled and limitations from these claims amended to claims 1 and 13. Claims 1 and 13 now recite “applying a surfactant solution” and “drying said surfactant solution.” As shown above, *Molitor* teaches a mold cavity preparation technique comprising in the first step shot peening or air blasting using an abrasive media. *See* col. 1, lines 24-59. “After blasting, the hemispherical opening and land area of the mold cavity are primed. *See id.* *Molitor* does not teach applying a surfactant solution. Accordingly, *Molitor* does not teach or suggest at least the above-recited limitations of claims 1 and 13. *Chen* teaches a metal support element that is “cleaned and dried” using any commercial cleaner or known solvent. *See* col. 8, lines 22-25. While commercial cleaners can contain surfactants, *Chen* does not teach or suggest applying and drying a surfactant solution. *See* Application, page 9, lines 3-14. Instead, *Chen* merely teaches cleaning the surface. Accordingly, *Chen* does not teach or suggest at least the above-recited limitations of claims 1 and 13. Thus, *Molitor* in view of *Chen* does not teach or suggest all limitations of claims 1 and 13.

Dependent claims 9-10 and 21-22 depend directly or indirectly from base claims 1 and 13. As such, each of the dependent claims comprise all limitations of the base claim from which it depends. As shown above, *Molitor* in view of *Chen* does not teach or suggest all limitations of claims 1 and 13. Accordingly, *Molitor* in view of *Chen* does not teach or suggest all limitations of dependent claims 9-10 and 21-22. Thus, claims 9-10 and 21-22 are not obvious over the cited references.

B. Claims 4, 6, 7, 16, 18, and 19

Claims 4, 6, 7, 16, 18, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Dutheil*. Each of dependent claims 4, 6, 7, 16, 18, and 19 depend directly or indirectly from base claims 1 and 13. Each dependent claim comprises

all limitations of the base claim from which it depends. As shown above, *Molitor* does not teach or suggest all limitations of claims 1 and 13. *Dutheil* teaches a metal substrate “which may have been subjected beforehand to one or more surface treatments such as alkali degreasing, brushing, shot-blasting, phosphatizing, hot rinsing, etc.”. *See* col. 2, lines 10-14. However, *Dutheil* does not teach or suggest at least the limitations of “applying a surfactant solution” and “drying said surfactant solution” as recited by claims 1 and 13. Accordingly, *Dutheil* does not cure the deficiencies of *Molitor* with respect to base claims 1 and 13. Thus, dependent claims 4, 6, 7, 16, 18, and 19 are not obvious over *Molitor* in view of *Dutheil*.

C. Claims 5 and 17

Claims 5 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Parthasarathy*. Each of dependent claims 5 and 17 depend directly or indirectly from base claims 1 and 13. Each dependent claim comprises all limitations of the base claim from which it depends. As shown above, *Molitor* does not teach or suggest all limitations of claims 1 and 13. *Parthasarathy* teaches “application of two layers of powder material on a substrate.” *See* col. 3, lines 4-5. However, *Parthasarathy* does not teach or suggest at least the limitations of “applying a surfactant solution” and “drying said surfactant solution” as recited by claims 1 and 13. Accordingly, *Parthasarathy* does not cure the deficiencies of *Molitor* with respect to base claims 1 and 13. Thus, dependent claims 5 and 17 are not obvious over *Molitor* in view of *Parthasarathy*.

D. Claims 3 and 15

Claims 3 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Molitor* in view of *Niskanen*. Each of dependent claims 3 and 15 depend directly or indirectly from base claims 1 and 13. Each dependent claim comprises all limitations of the base claim from which it depends. As shown above, *Molitor* does not teach or suggest all limitations of claims 1 and 13. *Niskanen* does not teach or suggest at least the limitations of “applying a surfactant solution” and “drying said surfactant solution” as recited by claims 1 and 13. Accordingly, *Niskanen* does not cure the deficiencies of *Molitor* with respect to base claims 1 and 13. Thus, dependent claims 3 and 15 are not obvious over *Molitor* in view of *Niskanen*.

Furthermore, the Examiner has not stated proper motivation for combining the two references. It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness. *See* M.P.E.P. § 2143.01. Here, the Examiner states that it would have been obvious to one of ordinary skill in the art to carry out the method of *Molitor* using the disclosure of *Niskanen* because of “the expectation of successfully forming golf balls in a composite mold.” Applicant respectfully asserts that the language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 46030/P031D1/10407127 from which the undersigned is authorized to draw.

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Respectfully submitted,

By 
Robert M. Chiaviello
Registration No.: 32,461
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, TX 75201-2784
(214) 855-8003
(214) 855-8200 (Fax)
Attorney for Applicant